

**REMARKS**

In the Office Action,<sup>1</sup> the Examiner:

- a) rejected claims 1-42 and 44 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2005/0137901 to Siegel (*Siegel*) in view of U.S. Patent No. 7,058,581 to Young (*Young*); and
- b) rejected claim 35 under 35 U.S.C. § 103(a) over *Siegel* in view of U.S. *Young* and further in view of U.S. Patent Publication No. 2001/0032143 Haseltine (*Haseltine*).

By this Amendment, Applicant amends claims 1, 5, 8, 10, 12, 15, and 18-34 and cancels claims 13 and 44 without prejudice or disclaimer of the subject matter thereof. Accordingly, claims 1-12 and 14-43 remain pending in this application, including independent claims 1, 8, 12, 18, 25, 29, and 34.

**I. Rejections under 35 U.S.C. 103(a) Based on *Siegel* in view of *Young*.**

Applicant respectfully traverses the 35 U.S.C. § 103(a) rejection of claims 1-42 and 44 as being unpatentable over *Siegel* in view of *Young*. The rejection of claims 13 and 44 is now moot due to their cancellation. A *prima facie* case of obviousness has not been established with respect to Applicant's pending claims.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." *M.P.E.P.* § 2142, 8th Ed., Rev. 7 (July 2008) (*internal citation and inner quotation omitted*). "[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103

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<sup>1</sup> The Office Action may contain a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III). Here, no *prima facie* case of obviousness has been established for at least the reasons that the Office Action has not properly determined the scope and content of the prior art and has not properly ascertained the differences between the claimed subject matter and the prior art.

Amended independent claim 1 recites a method for processing a product return using a plurality of management systems, comprising, among other things:

identifying an activity to be performed for [a] product based on [a] disposition decision, the activity comprising at least **an additional effort activity**; [and]

triggering [a] computer based first management system to perform at least **the additional effort activity** and [a] computer based second management system to perform [a] process [depending on the additional effort activity] (emphases added).

On page 3 of the Office Action, the Examiner concedes that *Siegel* does not disclose this language of amended claim 1, but asserts that *Young* allegedly overcomes these deficiencies of *Siegel*. This is incorrect.

*Young* relates to “a product distribution and return system... [for] a vending machine.” *Young*, Abstract. “The vending machine transaction 105 involves a consumer 116 activating a vending machine 118 to acquire a product 120 [e.g., a DVD] and a return mailer 122.” *Young*, col. 2, lines 47-50 and col. 3, lines 25-31. Once the consumer returns the product using the return mailer, the product is inspected to

determine whether it is the right product, whether it is in good condition, and whether it was returned on time. *Young*, col. 8, lines 19-30. If the returned product is not in good condition, is not the right product, or is late, the consumer is issued charges. *Young*, col. 8, lines 19-36

Thus, *Young* merely discloses inspecting the condition of a returned product in order to determine whether to issue charges to a consumer. However, inspecting the condition of a returned product in order to determine whether to issue charges to a consumer does not constitute “identifying an activity to be performed for [a] product based on [a] disposition decision, the activity comprising at least an **additional effort activity**,” as recited in amended claim 1 (emphasis added). This is at least because *Young* is **silent** with regard to “an additional effort activity” that is “to be performed for the product,” as recited in amended claim 1. Moreover, since *Young* does not disclose “an additional effort activity,” *Young* cannot disclose “**triggering** [a] computer based first management system to perform at least the **additional effort activity** and [a] computer based second management system to perform [a] **process [depending on the additional effort activity]**,” as recited in amended claim 1 (emphases added).

*Siegel* fails to remedy the deficiencies of *Young*. That is, *Siegel* also fails to disclose the above subject matter of amended claim 1.

In view of the above, the Office Action has neither properly determined the scope and content of the prior art, nor ascertained the differences between the claimed subject matter and the prior art. Moreover, the Examiner has not identified any factors that would have motivated one of ordinary skill in the art to modify the teachings of the prior art to achieve the claimed combination. Accordingly, no reason has been clearly

articulated as to why the prior art would have rendered independent claim 1 obvious to one of ordinary skill in the art. Therefore, a *prima facie* case of obviousness has not been established with respect to the claim and the rejection under 35 U.S.C. § 103(a) should be withdrawn.

Independent claims 8, 12, 18, 25, 29, and 34, while of different scope, recite elements similar to those of independent claim 1 and thus are allowable over the combination of *Siegel* and *Young* for reasons similar to those discussed above in regard to claim 1. Dependent claims 2-7, 9-11, 14-17, 19-24, 26-28, 30-33, and 35-42 are also allowable at least due to their dependence from one of the independent claims and further due to the elements recited therein.

**II. Rejection under 35 U.S.C. 103(a) Based on *Siegel* in view of *Young* and *Haseltine*.**

Applicant respectfully traverses 35 U.S.C. § 103(a) rejection of claim 43 as being unpatentable over *Siegel* in view of *Young* and *Haseltine*. A *prima facie* case of obviousness has not been established with respect to the claim.

Dependent claim 43 depends from allowable independent claim 34 and includes all recitations therein. As discussed, the combination of *Siegel* and *Young* fails to teach or suggest “identifying an activity to be performed for [a] product based on [a] disposition decision, the activity comprising at least an additional effort activity” and “triggering [a] computer based first management system to perform at least the [additional effort activity] and [a] computer based second management system to perform [a] process [depending on the additional effort activity]”, as recited in independent claim 34. *Haseltine* fails to remedy the deficiencies of *Siegel* and *Young*

by also failing to teach or suggest the above-noted elements recited in claim 34 and included in claim 43.

In view of the shortcomings of the references as set forth above, the Office Action has neither properly determined the scope and content of the prior art, nor ascertained the differences between the claimed subject matter and the prior art. Moreover, the Examiner has not identified any factors that would have motivated one of ordinary skill in the art to modify the teachings of the prior art to achieve the claimed combination. Accordingly, no reason has been clearly articulated as to why the prior art would have rendered claim 43 obvious to one of ordinary skill in the art. Therefore, a prima facie case of obviousness has not been established with respect to claim 43 and the rejection under 35 U.S.C. § 103(a) should be withdrawn.

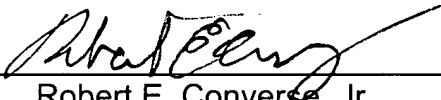
**CONCLUSION**

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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